

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Offic**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*Seitz*

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/305, 084 05/04/99 SCHNEIDER R 5914-080-999

020582  
PENNIE & EDMONDS LLP  
1667 K STREET NW  
SUITE 1000  
WASHINGTON DC 20006

HM22/1106

EXAMINER

HARRIS, A

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1642

DATE MAILED:

11/06/01

11

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**BEST AVAILABLE COPY**

|                              |                        |                  |
|------------------------------|------------------------|------------------|
| <b>Office Action Summary</b> | Application No.        | Applicant(s)     |
|                              | 09/305,084             | SCHNEIDER ET AL. |
|                              | Examiner               | Art Unit         |
|                              | Alana M. Harris, Ph.D. | 1642             |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 August 2001.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5, 14 and 15 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5, 14 and 15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit:1642

**DETAILED ACTION**

***Response to Amendment***

1. Claims 1-5, 14 and 15 are pending.

Claims 14 and 15 have been added.

Claims 1-5, 14 and 15 are examined on the merits.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Drawings***

3. The drawings are objected to because of reasons cited on attached form, PTO-948 completed by draftsman. Correction is required.

***Withdrawn Objections***

***Specification***

4. The disclosure is no longer objected to because the brief description of the drawings section contains a separate description of figures 4a-4j.

Art Unit:1642

***Claim Objections***

5. Claim 5 is no longer objected to because the claim does not contain the recitation “ or ribozyme”.

***Withdrawn Rejections***

***Claim Rejections - 35 U.S.C. § 112***

6. The rejection of claims 1-5 and 14 under 35 U.S.C. 112, first paragraph, because the specification, does not reasonably provide enablement commensurate with the scope of the claimed invention is withdrawn in view of Applicants arguments.

7. The rejection of claims 4 and 5 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of Applicant’s amendments and arguments.

***Claim Rejections - 35 U.S.C. § 102***

8. The rejection of claims 1, 4 and newly added claim 14 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 5,382,569 (January 17, 1995)/ Reference AP on IDS is withdrawn in view of Applicants’ arguments.

Art Unit:1642

9. The rejection of claims 1-4 under 35 U.S.C. 102(a) as being anticipated by Okazawa et al. (Journal of Biological Chemistry 273(20):12584-12592, May 15, 1998)/ Reference DC on IDS is withdrawn in light of Applicants' arguments.

*New Grounds of Rejection*

*Claim Rejections - 35 U.S.C. § 112*

10. Claims 1-5, 14 and 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The recitation "compound" in claims 1, 4, 5, 14 and 15 is vague and indefinite. The metes and bounds of the claim cannot be determined. A "compound" can be anything, such as a peptide, an organic molecule, an inorganic molecule, a DNA fragment, a plastic, a carbohydrate, etc. Applicant's attention is directed to Ex Parte Tanksley (26 USPQ2d 1384) wherein the Board noted that under 35 U.S.C. 112, second paragraph, the claims must be so definite as to allow the comparison with the available art and must also make it possible for the public to determine from the claim what it encompasses. How would one know if the patented claimed was being infringed?

Art Unit:1642

***Claim Rejections - 35 U.S.C. § 102***

11. Claim 14 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent number 6,063,911 (filed December 22, 1998). U.S. Patent #6,063,911 discloses an endothelin antagonist in column 3, lines 19-44 that can be used in a method for treating cancer. The disclosed endothelin B receptor is a non-peptide-based pyrimidyl sulfonamide compound. The said compound is 5-Isopropyl-pyridine-2-sulfonic acid [6-(2-hydroxy-ethoxy)-5-(2-methoxy-phenoxy)-2[2-(1H-tetrazol-5-yl)-pyridin-4-yl]-pyrimidin-4-yl]amide sodium salt (1:2), also termed Ro61. This antagonist, alone or in combination with other antitumor agents can be administered to patients to inhibit the growth and/or metastasis of tumor or other neoplastic cells (see bridging paragraph of columns 5 and 6; lines 4-16 of column 6; and Example 13 of columns 31 and 32).

***Conclusion***

12. Claims 1-5 and 15 are free of the art.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris whose telephone number is (703)306-5880. The examiner can normally be reached on Monday through Friday from 6:30 am to 4:00 pm, with alternate Fridays off. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703)308-4310. Any inquiry of a general nature or relating to the status of this

Art Unit: 1642

application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-0196.

Alana M. Harris, Ph.D.  
Patent Examiner, Group 1642  
November 5, 2001

*Sheela J. Huff*  
SHEELA HUFF  
PRIMARY EXAMINER